



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/086,867 | 03/04/2002 | Hiroaki Sato | 00449.00012 | 3965 |
| 22907 | 7590 | 01/10/2006 | EXAMINER GENACK, MATTHEW W | |
| BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001 | | | ART UNIT 2645 | PAPER NUMBER |

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,867

Applicant(s)

SATO, HIROAKI

Examiner

Matthew W. Genack

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 26-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: “, said first information indicating a characteristic of a mobile network to which said card belongs” and “ in which said apparatus is located, said second information indicating a characteristic of said mobile network in which said apparatus is located”.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2645

4. Claims 1-2, 26, 29, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Park *et. al.*, U.S. Patent No. 6,714,799.

Regarding Claim 1, Park *et. al.* discloses a system for enabling a subscriber of a GSM network to use his SIM card, associated with his GSM account, said GSM card mounted on a CDMA terminal that the user has in his possession during his time in an area with a CDMA network, said CDMA network in communication with the user's GSM network for purposes including the verification of the user's subscriber information (Abstract, Column 2 Lines 6-12, Fig. 4). The CDMA terminal includes a SIM interface for interfacing between a controller, also located inside the CDMA terminal, and the mountable SIM card (Column 2 Lines 15-18, Column 4 Line 62 to Column 5 Line 3, Fig. 3). The CDMA terminal of the disclosed invention reads information unique to the subscriber from the SIM card, and enables said SIM card after verification has been received (Column 2 Lines 18-22). When a GSM subscriber inserts his SIM card into a CDMA terminal of the disclosed invention, an initialization procedure is started, wherein the controller detects the insertion of the SIM card, then prompts the user for a password, and (if the correct password is inputted) then reads a first set of information from the SIM card and transmits said set of information to the CDMA network (Column 6 Lines 17-45, Fig. 5). A second set of information, comprising information relating to the identity of the GSM subscriber, is sent back from the CDMA network (after interfacing with the GSM network) to the CDMA terminal's interface, and the CDMA terminal is enabled if the GSM user is verified, said verification being based on a comparison of the two sets of information, and said CDMA terminal enablement procedure being inherent

Art Unit: 2645

to a table in the CDMA terminal's memory wherein basic telephone functions are stored (Column 6 Line 17 to Column 7 Line 25, Column 7 Lines 46-65, Figs. 2 and 5-6).

Claim 31 differs substantively from Claim 1 in that Claim 31 recites a time period for permitting the operation, said operation pertaining to the handling of an incoming call. This limitation reads on *Park et. al.* as follows: during the period in which the CDMA terminal with mounted SIM card is an enabled state of operation (said enabled state of operation corresponding to the aforementioned first and second information), the user may receive a telephone call from a CDMA user, a GSM user, or a wire line user (Column 8 Line 48 to Column 10 Line 24, Figs. 10-13), and accept said telephone call within the period of time in which the CDMA terminal with mounted SIM card is ringing.

Regarding Claim 2, *Park et. al.* discloses that both sets of information (traveling in opposite directions) comprise country code information (Column 6 Lines 33-42, Column 7 Lines 20-25, Figs. 5-6).

Regarding Claim 26, *Park et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33- 42, Fig. 5); the operation of enablement allows the user to make calls to or receive calls from one or more telephone numbers that may be stored in the CDMA terminal's memory (Column 10 Lines 60-65, Fig. 3).

Regarding Claim 29, *Park et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code and home

Art Unit: 2645

network code information associated with the user's CDMA terminal-mounted SIM card (Column 6 Lines 33- 42, Fig. 5).

Regarding Claim 32, during the enabled state of operation, the CDMA terminal with mounted SIM card may receive an incoming call, as outlined above.

Regarding Claim 33, Park *et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33-42, Fig. 5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.*

Park *et. al.* does not expressly disclose a memory that is a removably connected integrated circuit.

Examiner took official notice in the Office Action before last that the use of integrated circuits in cellular telephone memories is well known in the art. Further, any integrated circuit is removably connected to the system in which it is used because it may be unsoldered and removed as needed. Applicant's lack of traverse to the officially noticed fact in the Office Action before last is taken as an admission of the facts noticed.

Thus, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use an integrated circuit in the memory 34 (see Fig. 3) of the CDMA terminal. The modification is obvious since the use of integrated circuit chips is the current trend in the telecommunication industry.

7. Claims 27-28 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Anvekar *et. al.*, U.S. Patent No. 6,684,072.

Regarding Claims 27-28, Park *et. al.* discloses the presence of a display in the CDMA terminal with mounted SIM card (Fig. 3). Furthermore, Park *et. al.* discloses that both sets of information (traveling in opposite directions) comprise country code information (Column 6 Lines 33- 42, Column 7 Lines 20-25, Figs. 5-6).

Park *et. al.* does not expressly disclose the display of international roaming messages to indicate that a user is not in the country that his SIM card is registered in, nor the presence of caller ID features with the invention.

Anvekar *et. al.* discloses a global prepaid roaming service (Abstract, Column 1 Lines 39-49, Fig. 1). A cellular telephone using the disclosed invention keeps track of its own roaming status (Column 5 Line 36 to Column 6 Line 18, Fig. 7). Furthermore, Anvekar *et. al.* discloses the use of caller ID features with the roaming service of the disclosed invention (Column 7 Lines 32-38).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by providing for the display of roaming status and caller ID information for the CDMA terminal with mounted SIM card.

Art Unit: 2645

One of ordinary skill in the art would have been motivated to make this modification because of the different conditions, such as cost and quality of service, that may apply for a user when he is roaming in another network, and because roaming status may have a bearing on whether or not a user would like to accept a given call.

Regarding Claims 35 and 37-38, *Park et. al.* does not expressly disclose the determination of roaming status.

Anvekar et. al. discloses a global prepaid roaming service (Abstract, Column 1 Lines 39-49, Fig. 1). A cellular telephone using the disclosed invention keeps track of its own roaming status (Column 5 Line 36 to Column 6 Line 18, Fig. 7).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of *Park et. al.* by providing for the determination and the display of roaming status (either domestic or international), for the CDMA terminal with mounted SIM card, so as to enable handling of incoming calls while roaming.

One of ordinary skill in the art would have been motivated to make this modification because of the different conditions, such as cost and quality of service, that may apply for a user when he is roaming in another network, and because roaming status may have a bearing on whether or not a user would like to accept a given call.

Regarding Claim 36, *Park et. al.* discloses that the storage device used with the CDMA terminal is a removable SIM card associated with a GSM account (Abstract, Column 2 Lines 6-12).

8. Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Link, II *et. al.*, U.S. Patent No. 6,334,054, further in view of Haas *et. al.*, U.S. Patent No. 6,615,036.

Park *et. al.* does not expressly disclose that, while enabled, the CDMA terminal with mounted SIM card may do any one of the following: accept an incoming call, ignore an incoming call, forward an incoming call to a voice mail service, and recording a voice mail on the CDMA terminal with mounted SIM card.

Link, II *et. al.* discloses a wireless telephone that may accept an incoming call, reject an incoming call, and forward an incoming call to a voice mail system (Column 3 Lines 4-15, Column 7 Lines 17-28, Fig. 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by allowing the CDMA terminal with mounted SIM card in an enabled state of operation to accept an incoming call, ignore an incoming call, and forward an incoming call to a voice mail service.

One of ordinary skill in the art would have been motivated to make this modification because if a GSM user is enabled to use his account in a CDMA region, then it is natural that he would desire to use features that he is used to in his region.

Neither Park *et. al.* nor Link, II *et. al.* expressly discloses the practice of downloading and storing voice mail messages locally.

Hass *et. al.* discloses the practice of a remote unit in a cellular system downloading and storing a voice mail message locally (Abstract, Column 1 line 60 to Column 2 Line 5, Column 3 Lines 18-27, Fig. 1).

Art Unit: 2645

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* as modified by Link, II *et. al.* by providing for the downloading of voice mail messages by the CDMA terminal with mounted SIM card and storing said voice mail messages in said CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of convenience of having voice mail messages stored on one's cellular telephone, available for review at any time, regardless of the availability of cellular service.

Response to Arguments

9. Applicant's arguments filed 14 October 2005 have been fully considered but they are not persuasive. Regarding the new limitation to Claim 1 that is supported by the disclosure, "based on a comparison of said first and second information" Park *et. al.* explicitly states that a comparison of information is made to ensure agreement with respect to country and network information (MCC and MNC), prior to the enablement of the CDMA terminal with mounted SIM card (Column 6 Line 62 to Column 7 Line 8, Column 7 Lines 61-65, Figs. 5-6).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 703-605-4305. The examiner can normally be reached on FLEX.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Genack

Examiner

Art Unit 2645



5 January 2006



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600